

REMARKS

Claims 2-3, 5-9, 11-18, 20-35, and 37-60 are pending in this application; claims 28, 32, 37, and 41 being independent. In light of the remarks contained herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

The Official Action

In the outstanding Official Action, the Examiner rejected claims 2-3, 5-9, 11-18, 20-35, and 37-60 under 35 U.S.C. § 103(a) as being unpatentable over *Enomoto et al.* (USP 5,974,401) in view of *Garfinkle et al.* (USP 6,017,157). Applicants respectfully traverse these rejections.

In support of the Examiner's rejection, the Examiner admits that neither reference specifically discloses a shell extension to an operating system to describe file access and operating system commands. However, in interpreting the claim language, the Examiner's interpretation of the term "shell extension" to be any interface is too broad. It is respectfully submitted that while it is true that a shell extension is an interface, not all interfaces are shell extensions. One of ordinary skill in the art would interpret a shell extension as a small system utility that allows a user to access and configure the computer's operations. "Programming Windows NT No. 4 Unleashed," Mickey Williams and David

Hamilton, © 1996, describes the various shell extension types for windows NT. Various shell extensions include:

- Icon handlers for changing the appearance of a file's icon on a per-file object basis. By implementing this interface, for example, you can change the icon displayed for a file object based on its internal state, its age, or any other criteria.
- Copy hook handlers are invoked when a file object is copied, moved, or deleted. By implementing this interface, you can supplement or prevent the operation.
- Context menu extensions add items to the context menu displayed after a file object is right-clicked.
- Property sheet extensions add pages to the property sheet displayed by the shell for a particular type of file object.
- Drag and drop handlers are called after a drag and drop operation. They are almost identical to context menu extensions.
- Drop target handlers control the activity that occurs when a file object is dropped after a drag and drop operation.
- Data object handlers supply the file object during a drag and drop operation.

As can be seen from these different types of shell extensions, they provide for an interface for a user to access and configure the computer's operations. It would not be obvious to one of ordinary skill in the art to incorporate a shell extension to supply third image data to the user extension where the shell extension is capable of facilitating an order as set forth in claim 28. While Applicants admit that shell extensions are known within the context of an operating system, it is respectfully submitted that the use of shell extensions to facilitate the ordering of photo print related services in a network photo print system is not well known.

The digital print order system of *Enomoto et al.* provides for image processing-ordering software being installed on a personal computer after it is downloaded from the database 24 of the photo finisher 12. (Col. 3, lines 41-43). It is respectfully submitted that this software is installed on the personal computer and operates on top of the operating platform of the system. There is no teaching or suggestion in *Enomoto et al.* that this application be provided in a shell extension.

It is further respectfully submitted that the method of processing digital images set forth in *Garfinkle et al.* utilizes a graphical user interface to facilitate interaction between computers on the network. However, a graphical user interface is

not equivalent to a shell extension. A graphical user interface is a software application that operates on top of an operating platform. In contrast, a shell extension operates within the operating platform.

In order to sustain a claim rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

It is respectfully submitted that the Examiner admits that neither of the references, either alone or in combination (assuming these references may be combined, which Applicants do not admit), teach utilizing a shell extension for facilitating an order. Further, as noted above, it is respectfully submitted that it is not well known to one of ordinary skill in the art to utilize a shell extension to facilitate an order for photo print services. As

such, based upon the Examiner's failure to provide a reference that teaches or suggests all of the claimed elements, it is respectfully submitted that the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103.

With regard to the Examiner's rejection of claim 32, by this Amendment, Applicants have amended the claim to recite "uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information." It is respectfully submitted that *Enomoto et al.* discloses a digital print order and delivery method and system. *Enomoto et al.* discloses at col. 6, ll. 10-18:

Upon user's request for downloading sent from the connected personal computer 11 on the user side 10, the work station 13 of the photofinisher 12 sends out the image processing-ordering software to the personal computer 11 of the user side 10. The user 10 extracts the downloaded image processing-ordering software and installs it in the personal computer 11. If the installation is accomplished normally, a user registration menu appears, which helps the user register for the print order.

Additionally, *Enomoto et al.* discloses that upon receipt of an accept number and a message of acceptance at the personal computer 11, the user selects or designates the order execution after confirming the delivery date and the charge on the screen and then **sends the entire print order data to the work station 13. The**

entire print order data is constituted of all the print order data and the image data for the print (col. 7, ll. 13-19).

It is respectfully submitted that *Enomoto et al.* fails to disclose uploading the digital image to the external network entity or another external network entity subsequent to exchanging all ordering information. It is respectfully submitted that *Garfinkle* fails to cure the deficiencies of the teachings of *Enomoto et al.* (assuming these references are combinable, which Applicants do not admit), as *Garfinkle* fails to teach or suggest this element of claim 32. As such, it is respectfully submitted that claim 32, together with claims dependent thereon, are allowable over the art as cited by the Examiner.

It is respectfully submitted that claims 37 and 41 contain elements similar to those discussed above with regard to claim 32 and, thus, claims 37 and 41, together with claims dependent thereon, are not obvious over *Enomoto et al.* in view of *Garfinkle*.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinnet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

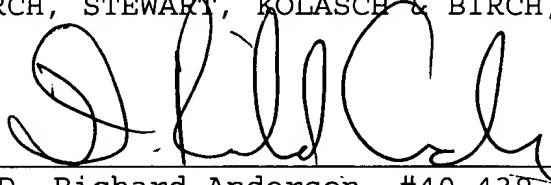
Appl. No. 09/372,750

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By


D. Richard Anderson, #40,439

^h
DRA/jdm
3352-0102P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000